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10/596,183

06/02/2006

Jeffrey A. Chapman

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

HINZE, LEO T

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

06/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/596,183 | Applicant(s) CHAPMAN, JEFFREY A. | |
| | Examiner LEO T. HINZE | Art Unit 2854 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Search Report from PCT/IB04/052691 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

2. The listing of references in the specification on p. 2 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

3. The disclosure is objected to because of the following informalities: the specification does not appear to be in the proper form for a US patent application. For example, the specification lacks the requisite headings, and the brief description of the drawings appears to be in the wrong location.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Regarding claims 4 and 5, both claims attempt to claim a product produced by a method. While such claims are permitted *per se* (See MPEP § 2113), in this case the claims appear to be indefinite. It is not clear from claims 4 and 5 which structural features that result from the method of claim 1 are relied upon to patentably distinguish the substrate of claims 4 and 5 from the prior art. To expedite prosecution, the examiner will consider any substrate with a printed patterned layer to be capable of satisfying the limitations of claims 4 and 5.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being obvious over Yamashita et al., US 5,367,953 A (hereinafter Yamashita) in view of Baek, US 7,520,220 B2 (hereinafter Baek).

a. Regarding claim 1:

Yamashita teaches a method of printing a patterned layer onto a substrate (col. 1, ll. 5-10), the method comprising: detecting the alignment of each of plural areas on the substrate (7, Fig. 1; col. 3, ll. 50-65) ; individually positioning subbeds of a printing machine in accordance with the detected alignment (6, Fig. 1); transferring material from a cliché supported on the subbeds onto a common carrier (Fig. 2a-2b); and transferring the material from the common carrier onto the substrate (Fig. 2c).

Yamashita does not teach wherein the cliché are clichés.

Baek teaches a cliché unit capable of forming a pattern using the cliché (col. 1, ll. 13-15), wherein the cliché is clichés, including a mother cliché and several sub clichés (col. 3, ll. 49-51; Fig. 5). Such an arrangement is advantageous for substantially obviating one or more problems due to limitations and disadvantages of the prior art (col. 3, ll. 32-34).

It has been held that mere duplication of parts is not sufficient to patentably distinguish an invention over the prior art. See MPEP §2144.04(VI)(B).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Yamashita wherein the cliché is multiple clichés, each arranged on a subbed, as taught by Baek, because this appears to be mere duplication of parts, and further, because Baek teaches that such an arrangement would

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predictably substantially obviate one or more problems due to limitations and disadvantages of the prior art.

b. Regarding claim 2:

Yamashita teaches a method of printing a patterned layer onto a first substrate (col. 1, ll. 5-10), the method comprising: detecting the alignment of each of plural areas on a second substrate (7, Fig. 1; col. 3, ll. 50-65; the second substrate can be, for example, the first one printed, and the alignment of each subsequent substrate can be based on the alignment of the first substrate printed); individually positioning subbeds of a printing machine in accordance with the detected alignment (6, Fig. 1); transferring material from a cliché supported on the subbeds onto a common carrier (Fig. 2a-2b); and transferring the material from the common carrier onto the substrate (Fig. 2c).

Yamashita does not teach wherein the cliché are clichés.

Baek teaches a cliché unit capable of forming a pattern using the cliché (col. 1, ll. 13-15), wherein the cliché is clichés, including a mother cliché and several sub clichés (col. 3, ll. 49-51; Fig. 5). Such an arrangement is advantageous for substantially obviating one or more problems due to limitations and disadvantages of the prior art (col. 3, ll. 32-34).

It has been held that mere duplication of parts is not sufficient to patentably distinguish an invention over the prior art. See MPEP §2144.04(VI)(B).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Yamashita wherein the cliché is multiple clichés, each arranged on a subbed, as taught by Baek, because this appears to be mere duplication

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of parts, and further, because Baek teaches that such an arrangement would predictably substantially obviate one or more problems due to limitations and disadvantages of the prior art.

c. Regarding claim 3, the combination of Yamashita and Baek teaches the method as claimed in claim 1, as discussed in the rejection of claim 1 above. The combination of Yamashita and Baek also teaches detecting (31; 61) the alignment of the clichés supported on the subbeds, and positioning the subbeds also in accordance with the detected alignment of the clichés (Yamashita: col. 3, ll. 50-65).

d. Regarding claim 4, the combination of Yamashita and Baek teaches the method as claimed in claim 1, as discussed in the rejection of claim 1 above. The combination of Yamashita and Baek also teaches a substrate provided with a printed patterned layer through the method of claim 1 (it appears that the substrate taught by Yamashita has the same structural characteristics as the claimed substrate).

e. Regarding claim 5, the combination of Yamashita and Baek teaches the substrate as claimed in claim 4, as discussed in the rejection of claim 4 above. The combination of Yamashita and Baek also teaches A device including a part of a substrate according to claim 4 (it appears that the substrate/device taught by Yamashita has the same structural characteristics as the claimed substrate/device).

f. Regarding claim 6:

Yamashita teaches a printing machine bed comprising a subbed (6, Fig. 1) individually alignable in a common plane (col. 3, ll. 50-65).

Yamashita does not teach wherein the subbed is an array of subbeds.

Baek teaches a cliché unit capable of forming a pattern using the cliché (col. 1, ll. 13-15), wherein the cliché is clichés, including a mother cliché and several sub clichés (col. 3, ll. 49-51; Fig. 5). Such an arrangement is advantageous for substantially obviating one or more problems due to limitations and disadvantages of the prior art (col. 3, ll. 32-34).

It has been held that mere duplication of parts is not sufficient to patentably distinguish an invention over the prior art. See MPEP §2144.04(VI)(B).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Yamashita wherein the cliché is multiple clichés, each arranged on a subbed, as taught by Baek, because this appears to be mere duplication of parts, and further, because Baek teaches that such an arrangement would predictably substantially obviate one or more problems due to limitations and disadvantages of the prior art.

g. Regarding claim 7, the combination of Yamashita and Baek teaches the bed as claimed in claim 6, as discussed in the rejection of claim 6 above. The combination of Yamashita and Baek also teaches an array of four or more individually alignable subbeds (Baek: Fig. 5 shows seven subbeds).

h. Regarding claim 8, the combination of Yamashita and Baek teaches the bed as claimed in claim 6, as discussed in the rejection of claim 6 above. The combination of Yamashita and Baek also teaches a controller operable to control alignment of the subbeds (Yamashita: Fig. 3).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is 571.272.2864. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571.272.2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Patent Examiner
AU 2854

/Judy Nguyen/
Supervisory Patent Examiner, Art Unit 2854